

REMARKS

I. Status of the Application

Upon entry of this amendment, claims 1-19 and 21-32 are pending in the present Application. In the Final Office Action mailed on July 27, 2007 (hereinafter "Office Action"), the Examiner objected to claim 10 because of certain claim informalities, rejected claims 1-3, 7-13, 15, 18, 20-27, and 29-32 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 7,130,284 (hereinafter "**Lee**"), rejected claims 4-6, 14, 16, 17, 19, and 28 under 35 U.S.C. §103(a) as being unpatentable over **Lee** in view of U.S. Publication 2004/0203469 (hereinafter "**Patel**") and U.S. Publication 2003/0139184 (hereinafter "**Singh**"), and rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over **Singh** in view of **Patel**.

II. The Presently Claimed Invention

The presently claimed invention claims a wireless device operable to communicate with first and second wireless communication networks of different radio access technologies. The device comprises a first modem processor operative to perform processing for a pending call with the first wireless network implementing a first radio access technology from 3rd Generation Partnership Project (3GPP), to receive a search message carrying a list of frequencies to search for cells in the second wireless network, and to provide notification of a handoff. The device also comprises a second modem processor operative to determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result, and to establish traffic channels as a result of the handoff.

III. The Cited References

The **Lee** reference discloses a method for performing a handoff from an async base station to a sync base station.

The **Patel** reference discloses a method for reducing latency for non-call delivery paging.

The **Singh** reference discloses a method for inter-system handovers in a mobile telecommunication system.

IV. Objections to the Claims

In Point #3 of the Office Action, the Examiner objected to claim 10 because of certain claim informalities. For example, the Examiner stated in the Office Action that the word “and” in claim 10 should be changed to “wherein.” Applicant herein amends claim 10 to conform to the Examiner’s suggested change. The word “and” is herein amended to “wherein the wireless device is.” Applicant respectfully requests that the Examiner’s objection to claim 10 be withdrawn.

V. Rejections Under 35 U.S.C. § 102(b)

In Point #5 of the Office Action, the Examiner rejected claims 1-3, 7-13, 15, 18, 20-27, and 29-32 under 35 U.S.C. §102(b) as being anticipated by **Lee**. Applicant herein amends claims 1, 13, 15, 18, 27, and 29, cancels claim 20, and submits that for the following reasons claims 1-3, 7-13, 15, 18, 21-27, and 29-32 are allowable under 35 U.S.C. §102(b).

Independent Claim 1

With respect to independent claim 1, Applicant herein amends claim 1 and submits that claim 1 is now allowable over **Lee** under 35 U.S.C. §102(b).

Claim 1 is herein amended to recite that a first modem processor is operative to:

“receive a search message carrying a list of frequencies to search for cells in the second wireless network”

And that a second modem processor operative to:

“determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result”

Support for the above amendments can be found for instance at paragraph [0053] of Applicant’s Specification. By searching frequencies in addition to those in a candidate list, the claimed invention compensates for a variety of network conditions so that the most handoff options can be determined. For example, due to transmission conditions, network upgrades, or overlapping cell boundaries there may be more pilots available than just the pilots that are identified in the candidate list. Thus, the claimed invention operates to determine all available

cell sites to determine the most handoff options.

Lee, however, fails to disclose or suggest the above-specified claim limitations. For example, **Lee** restricts the search for available pilots to those pilots identified in a received candidate list. For example, the Specification of **Lee** at (col. 13, lines 27-36) states:

“... the mobile station receives a message including information about the adjacent base stations from the async base station through a broadcast channel, in step 601. Here, the async base station sends to the mobile station information about the adjacent sync base stations together with the pilot offset PILOT_OFFSET and the frequency band of the individual sync base stations. In step 602, the mobile station measures the strengths of the pilot signals from the adjacent base stations using the received information about the adjacent base stations...” (emphasis added)

Thus, **Lee** fails to disclose or suggest searching for frequencies that are not provided in the list of frequencies received from the async base station.

In fact, **Lee teaches away from time consuming searches**. As can be seen with reference to the description of FIG. 3 provided at (col. 6, line 56 - col. 8, line 24), **Lee** teaches that the handoff process is a time critical process so that taking a long time to perform pilot searches is disadvantageous. For example, at (col 8, lines 24-27) **Lee** states:

“That is, taking a long time in performing the procedure of FIG. 3 results in a detrimental effect such as a loss of data communication between the async base station and the mobile station.”

This fact is further reinforced at (col. 15, lines 34-39);

“... the mobile station which has the knowledge of the zero offset time can search for the candidate cells with a small window size and send reliable search results to the base station in a shortest time, thereby reducing any potential risk of call disconnection.” (Emphasis added)

Therefore, it is clear that **Lee** teaches searching within a shortest time so that the risk of call disconnection can be avoided. This short search time is achieved by searching only those frequencies in the candidate list. To the contrary, claim 1 recites that additional frequencies can be searched so that the most possible handoff alternatives can be determined.

Therefore, **Lee** fails to disclose or suggest all the claim limitations of claim 1. In fact, **Lee** teaches away from the recited claim limitations. Accordingly, Applicant submits that claim 1 is allowable over **Lee** and respectfully requests that the Examiner's rejection under 35 U.S.C. §102(b) be withdrawn.

Independent Claims 13, 15, 17, 18, 27, and 29

With respect to independent claims 13, 15, 17, 18, 27, and 29, Applicant herein amends these claims to recite the limitations incorporated into claim 1. Since claim 1 is allowable over **Lee** under 35 U.S.C. §102(b), claims 13, 15, 17, 18, 27, and 29 are also allowable over **Lee** for at least the same reasons. Therefore, Applicant respectfully requests that the Examiner's rejection of independent claims 13, 15, 18, 27, and 29 under 35 U.S.C. §102(b) be withdrawn.

Dependent Claims 2-12, 14, 16, 21-26, and 30-32

With respect to dependent claims 2-12, 14, 16, 21-26, and 30-32, these claims are allowable over **Lee** for at least the same reasons as their independent base claims. Therefore, Applicant respectfully requests that the Examiner's rejection of dependent claims 2-12, 14, 16, 21-26, and 30-32 under 35 U.S.C. §102(b) be withdrawn.

VI. Claim Rejections Under 35 U.S.C. § 103(a)

In Point #7 of the Office Action, the Examiner rejected claims 4-6, 14, 16, 17, 19, and 28 under 35 U.S.C. §103(a) as being unpatentable over **Lee** in view of **Patel** and **Singh**. In Point #8 of the Office Action, the Examiner rejected claims 17 under 35 U.S.C. §103(a) as being unpatentable over **Singh** in view of **Patel**. Applicant submits that for the following reasons, these claims are allowable under 35 U.S.C. §103(a).

Claims 4-6, 14, 16, 17, 19, and 28

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d

1438 (Fed. Cir. 1991).

Applicant submits that the **Lee**, **Patel** and **Singh** references taken alone, or in any proper combination, fail to disclose or suggest all of recited claim limitations of claims 4-6, 14, 16, 17, 19, and 28. For example, Applicant submits that the **Lee**, **Patel** and **Singh** references fail to disclose or suggest a second modem processor that operates to “*determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result*” as discussed above. Thus, any proper combination of **Lee**, **Patel** and **Singh** would also fail to disclose or suggest such a claim limitation. Therefore, Applicant submits that claims 4-6, 14, 16, 17, 19, and 28 are allowable under 35 U.S.C. §103(a) for at least the same reasons as the independent claims from which they depend. Accordingly, Applicant respectfully requests that the Examiner’s rejection of these claims under 35 U.S.C. §103(a) be withdrawn.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that no new matter has been entered by way of this amendment and that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are respectfully requested. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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